



TTAB

TM

Docket No. 61497.00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

OPPOSITION (CANCELLATION) No. 92045152

James A. Frost, d/b/a Frost Cutlery)
v.)
Ginkgo International, Ltd.)
)
)



03-31-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

RESPONSE TO NOTICE OF DEFAULT

Commissioner for Trademarks
(TTAB)
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

On March 3, 2006, Registrant's attorney received a communication from the United States Patent and Trademark Office, Trademark Trial and Appeal Board (TTAB or Board), advising that an answer was due in the above-identified proceeding on December 24, 2005. The communication informed Registrant's attorney that inasmuch as it appears that no answer or motion to extend the time to answer had been filed, notice of default was entered against Applicant (Registrant) under Fed. R. Civ. P. 55(a). Applicant (Registrant) was allowed thirty (30) days from the mailing date of the order, February 28, 2006, to show cause why judgment by default should not be entered in accordance with Fed. R. Civ. P. 55(b). Registrant's attorney had never received any prior communication from the Board as to this matter, nor any inquiry from the Board as to Registrant's current address. (TBMP 310.01). Neither Registrant nor Registrant's attorney have any knowledge

as to whether or not the Board sent an inquiry to the Petitioner asking for the information concerning Respondent's current address in accordance with TBMP 310.02, but such information was obviously available from Petitioner's counsel.

In a footnote, the Board noted that a change of correspondence address had been filed via the USPTO's TEAS system on December 29, 2005, and that the Board had updated its records to reflect this change of correspondence address, but that the responsibility for any failure to receive any correspondence due a change of address of which the Board has not been given separate notice, lies with the party or its attorney or other authorized representative. Registrant's Attorney is aware that the Board is to be given separate notice as to proceedings being conducted before the Board. Such a change of address has been separately given by Registrant's attorney in all of the current proceedings pending before the Board of which Registrant's Attorney was aware. However, in regard to the instant proceeding, neither Registrant nor Registrant's Attorney received a copy of the Petition for Cancellation until after the Notice of Default was received, when a copy of the Petition was then obtained from the Board's record of this proceeding.

For the reasons hereinafter set forth, Registrant respectfully submits that good cause is shown for setting aside the entry of default under Fed. R. Civ. P. 55(a). In addition, enclosed is Registrant's Answer to Petitioner's Petition To Cancel which the Board is respectfully requested to accept.

FACTUAL BASIS FOR SETTING ASIDE THE ENTRY OF DEFAULT

On November 4, 2005, counsel for Petitioner, J.A. Frost (Frost), sent a letter to Registrant, Ginkgo International Ltd. (Ginkgo) by certified mail, return receipt requested, stating that counsel represented Frost, and advised Ginkgo that Petitioner's application to register the mark PATRIOT TACTICAL I had been refused in view of Ginkgo's PATRIOT trademark registration. Both marks are in International Class 8, but for separate and distinct goods. Frost's counsel requested Ginkgo to enter into a consent agreement to permit the registration of Frost's mark, and advised Ginkgo that if Ginkgo was not willing to enter into such a consent agreement, Frost would file for a cancellation of Ginkgo's trademark registration. Ginkgo was advised that Frost faced "a deadline of November 9, 2005, to respond to the Examiner and hope that (the parties) could reach at least some preliminary agreement before then." That letter was faxed to Ginkgo the afternoon of November 8, 2005. (Exhibit 1 to Helmick Declaration).

On the same day Ginkgo received the fax, November 8, 2005, Registrant faxed a copy of this letter to Registrant's attorney. Later that same day, counsel for Frost called Mr. Helmick (President of Ginkgo) and faxed a second letter dated November 7, 2005, advising Ginkgo that

"... in the abundance of caution and in order to preserve (Petitioner's) rights, in view of our due date of today to respond to the examiner's final refusal of our client's application, (Petitioner has) taken the precaution of filing a petition to cancel (Ginkgo's) registration for the mark PATRIOT. The petition can be withdrawn should we come to an agreement permitting concurrent use of the subject marks." (Exhibit 2 to Helmick Declaration).

That letter was then also faxed to Registrant's attorney by Mr. Helmick (Registrant).

No further communications were received from Petitioner's attorney, or the Board, until the Notice of Default was sent to Registrant's attorney. Petitioner's application may have been allowed, or the petition withdrawn. It was not until Registrant's attorney received the Board's letter mailed February 28, 2006, advising that a Notice of Default had been entered, that Registrant became aware

that its registration was at issue. Neither Registrant nor Registrant's attorney ever received the Petition To Cancel, nor any other communication as to this matter except the Notice of Default.

GOOD CAUSE EXISTS TO JUSTIFY SETTING ASIDE AN ENTRY OF DEFAULT

A Notice of Default does not carry the full weight of an entry of a default judgment. Accordingly, Courts are encouraged to take a liberal approach in determining whether "good cause" has been shown under Rule 55(c) to justify setting aside an entry of default, particularly when the default was relatively brief, caused by poor communications and does not appear to cause any prejudice to the Petitioner. Johnson v. Dayton Elec. Mfg. Co., 140 F.3d 781, 784-785 (8th Cir. 1998). The standards for relief from an entry of default, "good cause," are more liberal than those for relief from the entry of a default judgment which requires a party to meet the requirements of Rule 60(b) FRCP. In Moore's Federal Practice, Section 55.50[1] (Matthew Bender 3 Ed.). Relief from default is an interlocutory matter, while relief from entry of a default judgment seeks relief from a final judicial action. As stated in the TBMP 312.02, it is the policy of the law to decide cases on their merits. Here, neither Registrant nor its attorney ever received the Petition To Cancel from the Board.

Registrant has obtained a portion of the prosecution history of Petitioner's mark, and Petitioner has steadfastly contended that there would be no likelihood of confusion arising from the parties' concurrent use of their respective marks for their respective products. This was the basis for Petitioner's counsel contacting Registrant, and Petitioner's counsel's letters to Registrant dated November 4, 2005, and November 7, 2005. It is quite apparent that the instant Petition To Cancel was filed only because Petitioner was required to submit a response to the United States Patent and Trademark Office on or about November 8, 2005, the day after speaking with Mr. Helmick about this matter.

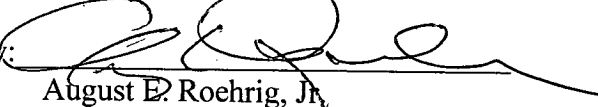
Because Registrant had received no further communications in regard to its trademark registration, it was believed that nothing further was required. Obviously no discovery has been taken as to the parties' contentions, nor have the parties been able to discuss Petitioner's position that the contemporaneous use by the parties of their respective marks is not likely to cause confusion. Registrant is in agreement with Petitioner's position, and believes this matter can be settled without a lot of unnecessary expense and legal fees.

Registrant believes that these facts are sufficient to substantiate a meritorious position in this proceeding. The initial communications between the parties prior to and after Petitioner's filing of the instant Petition To Cancel should have permitted the Petition To have been served on Registrant so that appropriate action could have been taken. It is respectfully submitted that these communication failures

do not reflect upon the merit of Registrant's position. Registrant has never had the opportunity to answer the Petition, because the Petition was never received. Accordingly, it is respectfully requested that the Notice of Default be vacated, and Registrant's enclosed Answer be accepted as timely.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

Date: March 22, 2006 By: 
August E. Roehrig, Jr.

P.O. Box 1871
Knoxville, TN 37901
Phone: 865-546-4305
Fax: 865-523-4478

Attorneys for Registrant
Ginkgo International, Ltd.



Docket No. 61497.00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

OPPOSITION (CANCELLATION) No. 92045152

James A. Frost, d/b/a Frost Cutlery)
)
v.)
)
Ginkgo International, Ltd.)
)
)

Commissioner for Trademarks
(TTAB)
P.O. Box 1451
Alexandria, VA 22313-1451

DECLARATION OF WESLEY S. HELMICK

I, Wesley S. Helmick, submit this Declaration in support of the response by Ginkgo International, Ltd. (Ginkgo) to the Notice of Default in the above-identified cancellation proceeding seeking to cancel our PATRIOT trademark. I declare, based upon my personal knowledge and corroborated by the attached exhibits, that my following statements are true and correct as to those matters of which I have personal knowledge, and that all statements made on information and belief are believed to be true and correct:

1. I am President of Ginkgo International, Ltd. (Ginkgo), the Registrant of U.S. Trademark Registration No. 2,789,847 for our trademark PATRIOT.
2. I have held this office since the corporation was formed.
3. Attached hereto as Exhibit 1 is a copy of a letter dated November 4, 2005, which was sent to Ginkgo by counsel for James A. Frost (Frost).
4. Attached hereto as Exhibit 2 is a copy of a letter dated November 7, 2005, which was sent to me by counsel for Frost, after Frost's attorney called me earlier in the day concerning a conflict between our PATRIOT trademark registration and Frost's application for PATRIOT TACTICAL I.

5. I received no further communication from Frost's attorney after receiving these two letters and their telephone call.

6. I never received any communication from the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board, concerning any conflict between our trademark registration and the Frost application.

7. It was not until my Attorney called me asking if we had received any communication from the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board, in regard to this matter that I was aware that I should have received official notification from them, which I had not received.

8. In my opinion there is no likelihood of confusion arising from the concurrent use by the parties of their respective trademarks for their respective goods.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statement and the like so made are punishable by fine or imprisonment, or both, under Section 101 of Title 18 of the United States Code.

GINKGO INTERNATIONAL, LTD.

Date:

March 25, 2006

Wesley S. Helmick
Wesley S. Helmick, President

BLANK ROME

Fax: 202-463-6917

Nov 8 '05 12:59 P.02

BLANK  **ROME** LLP
COUNSELLORS AT LAW

20/3

Phone: (202) 772-5870
Fax: (202) 592-1407
Email: ftohr@blankrome.com

November 4, 2005

CERTIFIED MAIL AND RETURN RECEIPT REQUESTED

Ginkgo International, Ltd.
5107 Chase Street
Downers Grove, Illinois 60515

Re: Ginkgo International, Ltd. Trademark Registration for PATRIOT

Dear Sir or Madam:

This firm represents Frost Cutlery Company ("Frost Cutlery"), in connection with intellectual property matters. I am writing in reference to Ginkgo International Ltd.'s ("Ginkgo"), United States trademark Registration No. 2,789,847 for PATRIOT for table flatware, namely, knives, forks, and spoons. Frost Cutlery is the owner of a United States trademark application, Application No. 78/340,751, for the mark PATRIOT TACTICAL I for cutlery, namely pocket and collector's knives, filed December 15, 2003. The Trademark Examiner at the United States Patent and Trademark Office assigned to Application No. 78/340,751 has indicated that she will refuse registration to Frost Cutlery's mark in view of Ginkgo's registration for its PATRIOT mark.

While Frost Cutlery and Ginkgo both sell knives, we are inclined to believe that the marks are quite dissimilar in appearance, are marketed in different channels of trade and readily distinguishable by consumers. Our preliminary research found that Ginkgo primarily sells table flatware. In contrast, Frost Cutlery uses and intends to register the mark for use in connection with pocket and collector's knives. In our view, both companies' customers are savvy purchasers and are unlikely to be confused because the marks are different and the goods are distinguishable. Furthermore, Frost Cutlery has used its PATRIOT TACTICAL I mark since at least as early as December 31, 2002, while Ginkgo has used its mark since June 30, 2003. As consumer confusion has not arisen in the years of concurrent use, Frost Cutlery requests that Ginkgo enter into a consent agreement with Frost Cutlery by which Ginkgo will permit registration of Frost Cutlery's mark. In the event that Ginkgo is not willing to enter into a consent agreement with Frost Cutlery, however, Frost Cutlery will have no other viable option other than to file a cancellation of Ginkgo's trademark registration, based on priority of use.

Watergate 600 New Hampshire Ave., NW Washington, DC 20037
www.BlankRome.com

EXHIBIT

1

BLANK ROME

Fax: 202-463-6917

Nov 8 '05

13:00

P.03

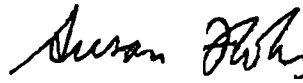
BLANK  ROME LLP
COUNSELORS AT LAW

November 4, 2005

Page 2

We currently face a deadline of November 9, 2005, to respond to the Examiner, and hope that we can reach at least some preliminary agreement before then. Please feel free to call or e-mail should you have any questions or require additional information. Thank you for your consideration of this matter.

Sincerely,



Susan B. Flohr

SBF/ZAA

BLANK ROME

Fax: 202-453-6917

Nov 8 '05

16:20

P.02

BLANK ROME III
COUNSELORS AT LAW

Phone: (202) 772-3870
Fax: (202) 572-1487
Email: sflohr@blankrome.com

November 7, 2005

VIA FACSIMILE

Mr. Wesley Helmick
Ginkgo International, Ltd.
5107 Chase Street
Downers Grove, Illinois 60515

Re: Ginkgo International, Ltd. Trademark Registration for PATRIOT
James A. Frost Application for PATRIOT TACTICAL I
Our ref: 115042-00148

Dear Wesley:

Further to our telephone conversation earlier today and my fax of this afternoon, please note that in the abundance of caution and in order to preserve my client's rights, in view of our due date of today to respond to the examiner's final refusal of our client's application, I have taken the precaution of filing a petition to cancel your company's registration for the mark PATRIOT. The petition can be withdrawn should we come to an agreement permitting concurrent use of the subject marks.

It is understood that you will be providing my earlier fax, and I assume, this one to your attorneys for further action.

I look forward to hearing from them and to working out a mutually beneficial resolution to this situation.

Best wishes,

Sincerely,

Susan
Susan B. Flohr

SBF/kar

EXHIBIT2

Watergate 600 New Hampshire Ave., NW Washington, DC 20037
www.BlankRome.com

BLANK ROME

Fax: 202-460-0911

NOV 8 05 12:59 P.01

ATTN: A.E. ROEHKIG

NOV 8 - 2005

FAX
603-9264171BLANK  ROME LLP
COUNSELORS AT LAW

NOV - 8 2005

FAXED
11/08

FAX TRANSMITTAL FORM

Date: November 8, 2005

10/3

TO:	FIRM:	FAX NO.:	CONFIRMATION NO.:
1. Wesley Helmick	Ginkgo International, Ltd.	630-910-5279	

From:	Susan B. Flohr
Phone:	202-772-5870
Fax:	202-572-1407
Email:	flohr@blankrome.com

of Pages: 3
(Include cover)

ORIGINAL:	WHEN COMPLETED:
Will Follow:	Call For Pickup:
Will Not Follow: X	Send Interoffice:

COVER MESSAGE:

The documents accompanying this fax transmission contain information, which may be confidential and/or legally privileged, from the law firm of Blank Rome LLP. The information is intended only for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this faxed information is strictly prohibited, and that the documents should be returned to this firm immediately. If you have received this in error, please notify us by telephone immediately at the number listed above, collect, so that we may arrange for the return of the original documents to us at no cost to you. The unauthorized disclosure, use, or publication of confidential or privileged information inadvertently transmitted to you may result in criminal and/or civil liability.

TRANSMITTED BY:	DATE SENT:	TIME SENT:	TIME CALLED:
BUSY:	NO ANSWER:	WRONG NUMBER:	NO CONNECTION:

3. Registrant has no personal knowledge, and has insufficient knowledge or information as to the truth of the allegations set forth in paragraph 3 of the Petition to Cancel to form a belief, and, therefore, must deny said allegations.

4. Registrant has no personal knowledge, and has insufficient knowledge or information as to the truth of the allegations set forth in paragraph 4 of the Petition to Cancel to form a belief, and, therefore, must deny said allegations.

5. Registrant has no personal knowledge, and has insufficient knowledge or information as to the truth of the allegations set forth in paragraph 5 of the Petition to Cancel to form a belief, and, therefore, must deny said allegations.

WHEREFORE, Registrant prays that the cancellation proceeding be dismissed with prejudice.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

Date: March 22, 2006

By: 

August E. Roehrig, Jr.

P.O. Box 1871
Knoxville, TN 37901
Phone: 865-546-4305
Fax: 865-523-4478

Attorneys for Registrant
Ginkgo International, Ltd.

Certificate of Mailing


I hereby certify that the following papers:

Response to Notice of Default
Declaration of Wesley S. Helmick
Answer to Petition to Cancel

are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner of Trademarks
TTAB
P.O. Box 1450
Alexandria, VA 22313-1451

Date: March 27, 2006


August E. Roehrig, Jr.
Reg. No. 22,667

Certificate of Service

I hereby certify that a true and correct copy of the following listed papers:

Response to Notice of Default
Declaration of Wesley S. Helmick
Answer to Petition to Cancel

are being served on counsel of record, by first class mail, postage prepaid, addressed as follows:

Susan B. Flohr, Esq.
Blank Rome, LLP
600 New Hampshire Avenue, NW
Washington, DC 20037

Date: March 27, 2006


August E. Roehrig, Jr.